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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/632,861      | 08/04/2000  | Masayuki Chatani     | 375.05.01           | 2447             |

25920 7590 10/22/2003

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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/632,861

Applicant(s)

CHATANI, MASAYUKI

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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#### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
  - Claims 1-4 and 6-11 are amended.
  - Claims 13-16 are canceled.
  - Claims 17-24 are added
  - Claims 1-12 and 17-24 have been considered.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 August 2003 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-12 and 17-24 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

4. Claims 1, 9, and 17 objected to because of the following informalities:
  - Claim 1 contain the phrase "enable access to specific content...". Examiner feels that instead the phrase "enable access to a specific content..." would read clearer in relaying the context.
  - Claim 9 contains the phrase "a request for specific content...". Examiner feels that instead the phrase "a request for a specific content..." would read clearer in relaying the context.

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- Similarly claim 17 contains the phrase “for specified content...”. Examiner feels that instead the phrase “for a specified content...” would read clearer in relaying the context.
- Appropriated correction is requested.
- Claims 19 and 22 contain the phrase “content is downloaded the client...” which renders the claim indefinite, examiner suggest that the phrase be changed to “content is downloaded to the client...”.

***Claim Rejections - 35 USC § 103***

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo and U.S. Patent No. 5,530,754 to Norton Garfinkle in view of U.S. Patent No. 5,063,547 to Pieter H. Custer.

6. As per claims 1 and 9, both Russo and Garfinkle disclose a method and system for providing access to primary media content in digital form, comprising:

- a server network comprising a download management server, a customer database storing user information, and a primary content database storing primary media content (See Russo figures 1, 2 and associated text, column 3, lines 1-28, and column 4, lines 22-68, and Garfinkle figures 1, 2, 3, and 5 and associated text, column 2, lines 39-68, and column 3, lines 1-19);
- a client console connectable for establishing a communications link through a bi-directional communications network to said download management server (See Russo figures 1, 2 and associated text, column 3, lines 1-28, column 4, lines 22-68, and column 5, lines 1-65, and Garfinkle figures 1, 2, 3, and 5 and associated text, and column 4, lines 2-6);
- the client console storing user specific information (See Russo column 6, lines 8-63);
- a detachable storage media installable in said client console (See Russo column 7, lines 34-61 and Garfinkle figures 1, 2, 3, and 5 and associated text, and column 1, lines 48-57);
- said detachable storage media having a media identifier (See Russo column 7. lines 34-61 and Garfinkle figures 1, 2 and associated text and column 2, lines 39-68),

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- the user identifier is uploaded to said download management server to enable access to specified content in said primary media content database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- said specified content and said user information is downloaded to said client console (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the specified content being associated with billing trigger data to enable monitoring of when specific portions of the specified content is accessed for use at said client console (See Russo column 3, lines 1-28, column 5, lines 1-64, column 10, lines 11-68, and column 11, lines 1-15),
- the monitoring being configured to generate a record of used content (See Russo column 10, lines 10-68),
- the record of used content being communicated back to the management server to record a revenue bearing event in the customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- Charging only for portion of the specific content used at the client console (See Russo figure 2 and associated text, and column 5, lines 1-9, column 5, lines 33-65, column 9, lines 38-65, and column 10, lines 10-48),
- wherein the media identifier is combined with the user specific information to define a user identifier (See Custer abstract, figures 2 and 3 and associated text, column 2, lines 3-34, column 4, lines 3-23, and column 6, lines 34-63),

Though, Russo or Garfinkle are not clear about the specifics of the identification data transmitted between the client console and the central server. However, Custer is clear on how to achieve a better security and make the identification data associated with both specific end user as well as to an specific content by combining the user specific information and specific content information to create an ID (See Custer column 2, lines 3-35, column 4, lines 3-52, column 5, lines 25-29, and column 6, lines 34-52). Accordingly, it would have been obvious to one having

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ordinary skill in the art at the time the current invention was made to combine the teachings of Russo and Garfinkle, and Russo to achieve the uniqueness of the ID (identification data) that is needed for distribution of specific content to and end user (Motivation can be found in Russo column 8, lines 19-40).

7. As per claim 2, Russo, Garfinkle, and Custer disclose all the limitations of claim 1, further; Russo discloses,

wherein said user identifier comprises an alphanumeric media ID identifying said detachable storage media said alphanumeric media ID defining a level of access available when accessing the primary media content database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),.

8. As per claim 3, Russo, Garfinkle, and Custer disclose all the limitations of claim 2, further; Russo discloses,

wherein said specified content comprises a portion of an overall set of primary contents stored in said contents database, and wherein said media ID serves to limit access to particular ones of the overall set of primary contents of the specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

9. As per claim 4, Russo, Garfinkle, and Custer disclose all the limitations of claim 1, further; Russo discloses,

wherein said specified content is associated with an authentication code for authenticating access to the download management server (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

10. As per claim 5, Russo, Garfinkle, and Custer disclose all the limitations of claim 4, further; Russo discloses,

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wherein said specified content comprises a portion of an overall set of primary contents stored in said contents database, and wherein said authentication code authenticates access to the download management server which is responsible for providing access to said specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

11. As per claim 6, Russo, Garfinkle, and Custer disclose all the limitations of claim 1, further; Russo discloses,

wherein each portion of the specified content is associated with respective billing trigger data, the billing trigger data tracks usage to generate a usage history of the primary media content in the customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

12. As per claim 7, Russo, Garfinkle, and Custer disclose all the limitations of claim 6, further; Russo discloses,

wherein said detachable storage media includes a program for providing network access and code which causes execution of a program stored in said media console for providing network access (See Russo column 7, lines 34-61, and column 9, lines 11-68).

13. As per claim 8, Russo, Garfinkle, and Custer disclose all the limitations of claim 1, further; Russo discloses,

wherein said client console further comprises a local fixed storage device disposed internally or externally of said client console, wherein said specified content is downloaded only to said fixed storage device (See Russo figure 2 and associated text, column 4, lines 45-65, column 5, lines 33-65, column 6, lines 12-53, column 8, lines 11-19, and column 10, lines 54-59).

14. As per claim 10, Russo, Garfinkle, and Custer disclose all the limitations of claim 9, further; Russo discloses,

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wherein said media ID identifies said detachable storage media, further comprising the step of receiving said media ID and an authentication code from said client console at said download management server, wherein one of said authentication code and said media ID server to limit access to particular portion of said primary media content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

15. As per claim 11, Russo, Garfinkle, and Custer disclose all the limitations of claim 9, further; Russo discloses,

wherein the billing trigger data assists in compiling usage information of the specified content in a customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

16. As per claim 12, Russo, Garfinkle, and Custer disclose all the limitations of claim 9, further; Russo discloses,

wherein said step of downloading to said client console from said download management server comprises storing said specified content on a local fixed storage device disposed internally or externally of said client console (See Russo figure 2 and associated text, column 4, lines 45-65, column 5, lines 33-65, column 6, lines 12-53, column 8, lines 11-19, and column 10, lines 54-59).

17. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.



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18. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo in view of U.S. Patent No. 5,063,547 to Pieter H. Custer.

19. As per claim 17 and 20, Russo discloses a method and computer readable media having program instructions for obtaining media content at a client computer, comprising:

- communicating a request from the client computer to a content provider for specified content (See Russo figures 1, 2 and associated text, column 3, lines 1-28, and column 4, lines 22-68),
- the request including a media ID of a detachable media and user information (See Russo column 6, lines 8-63 and column 7, lines 34-61),
- downloading the specified content to the client computer (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the specified content being associated with billing triggering data (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the billing triggering data being configured to assist in tracking when portions of the specified content is used at the client computer (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38); and
- returning information regarding the tracked usage of the portions of the specified content to the content provider (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the media ID and the user information defining a user identifier (See Custer abstract, figures 2 and 3 and associated text, column 2, lines 3-34, column 4, lines 3-23, and column 6, lines 34-63),

Though, Russo or Garfinkle are not clear about the specifics of the identification data transmitted between the client console and the central server. However, Custer is clear on how to achieve a better security and make the identification data associated with both specific end user as well as to an specific content by combining the user specific information and specific content information to create an ID (See Custer column 2, lines 3-35, column 4, lines 3-52, column 5, lines 25-29, and

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column 6, lines 34-52). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Russo and Garfinkle, and Russo to achieve the uniqueness of the ID (identification data) that is needed for distribution of specific content to and end user (Motivation can be found in Russo column 8, lines 19-40).

20. As per claim 18 and 21, Russo and Custer disclose all the limitations of claim 17 and 20, further;

Russo discloses,

wherein the tracked usage is associated with the user information to enable billing for the usage of the portions of the specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

21. As per claims 19 and 22, Russo and Custer disclose all the limitations of claims 17 and 20, further;

Russo discloses,

wherein the specified content is downloaded the client computer, but billing for the downloaded specified content is not triggered until usage of at least a portion of the specified content at the client computer (See Russo figure 2 and associated text, and column 3, lines 1-28, column 5, lines 1-65, column 6, lines 12-33, and column 10, lines 10-38).

22. As per claim 23, Russo and Custer disclose all the limitations of claims 17 and 20, further;

Russo discloses,

wherein the computer readable media is packaged media (See Russo column 7, lines 34-61).

23. As per claim 24, Russo and Custer disclose all the limitations of claims 17 and 20, further;

Russo discloses,

wherein the packaged media is a compact disc (See Russo column 7, lines 34-61).

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24. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

**Conclusion**

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

27. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
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or faxed to:

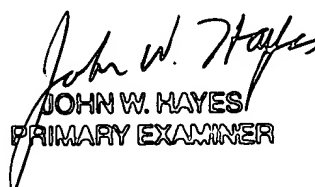
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive  
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K  
October 16, 2003**

  
**JOHN W. HAYES  
PRIMARY EXAMINER**